The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZHIJUN QU and KENNETH WAGERS

MAILED
JUL 21 2004
PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-0165
Application No. 09/329,156

ON BRIEF

Before GARRIS, GROSS, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is hereby remanded to the examiner for appropriate action consistent with our comments below.

On page 2 of the final Office action mailed May 21, 2002, the examiner rejected claims 1-4 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Ishimura. On page 4 of the answer, the examiner reiterated this Section 103

rejection over Akiyama in view of Ishimura and then set forth an alternative Section 103 rejection over Ishimura in view of Akiyama. This alternative rejection was expounded upon at pages 6-7 and 12-13 of the answer.

On page 1 of the appellants' reply (i.e., paper no. 24 filed June 16, 2003) to the examiner's answer, the appellants urged that the alternative rejection over Ishimura in view of Akiyama constituted a new ground of rejection. Additionally, on pages 1-2 of the reply, the appellants further urged that the rejection over Akiyama in view of Ishimura as presented in the answer was also a new ground of rejection because the examiner's position with respect thereto and the issues raised thereby are distinct from the position taken and the issues raised with respect to the final rejection over Akiyama in view of Ishimura as presented in the final Office action. On page 2 of the reply, the appellants summarize their view of these matters with the following language:

> When new grounds for rejection are raised for the first time on appeal, the appellant is [sic, appellants are] unfairly deprived of the opportunity to amend claims in response to the Examiner's new positions. It is respectfully submitted that the proper course of action would have been to reopen prosecution in order to have the appellant [sic, appellants] consider the Examiner's new positions, and if necessary

> amend the claims to address those positions. Such course of action is still possible as provided by Rule 193(b)(1)(the Examiner may enter the Reply Brief or reopen prosecution.) However, should the Examiner insist on relying on the new grounds in the Answer, it is respectfully submitted that the Board should remand the application to the Examiner pursuant to M.P.E.P. § 1211 with instructions to reopen the case for Ex parte prosecution so that the Examiner's new positions may be addressed properly.

The examiner responded to the appellants' reply via paper no. 25 mailed June 26, 2003 by stating that "[t]he reply brief filed on June 16, 2003, has been entered and considered" and that "[t]he application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal." Thus, the examiner's response does not even acknowledge much less address the appellants' contention that both of the rejections presented in the answer constitute new grounds of rejection relative to the final rejection presented in the final Office action. This is inappropriate.

If the examiner agrees with the appellants that one or both of the rejections presented in the answer constitute new grounds of rejection, the answer must be withdrawn and prosecution must be reopened as explained in more detail at Section 1208.01 and the Manual of Patent Examining Procedure (MPEP)(8th Ed., Rev. 1, Feb. 2003). On the other hand, if the examiner disagrees with

the appellants on these matters, the examiner must provide the appellants with a written denial of their request that prosecution be reopened along with an explanation of the basis for this denial so that the appellants may then, if they desire, seek supervisory review (see Chapter 1000 generally of the MPEP) of the examiner's denial of their request.

Pursuant to 37 CFR § 1.193(b)(1), we hereby authorize the examiner to prepare a supplemental examiner's answer though solely for the purpose of responding to the above discussed reply brief (i.e., no new ground of rejection is to be presented or discussed in such a supplemental answer). See MPEP § 1211 (8th Ed. Rev. 1, Feb. 2003). Correspondingly, the appellants will be permitted to file a supplemental reply brief in response to any such supplemental answer.

This application, by virtue of its "special" status requires an immediate action. See Manual of Patent Examining Procedure (MPEP) 708.01(D)(8th Ed., Rev. 1, Feb. 2003). It is important that the Board be informed promptly of any action affecting the appeal in this application.

REMANDED

BRADLEY R. GARRIS)
Administrative Patent Judge)
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ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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JEFFREY T. SMITH)
Administrative Patent Judge)

BRG/hh

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